

**REMARKS**

The Office Action mailed 28 July 2004, for the present application has been reviewed. The present amendment cancels claim 16 and amends claims 1, 4, 8, 14, 17, 19, 20, 21 and 22, which are resubmitted for further consideration. Considered together with the following remarks, these amendments are believed sufficient to place the application into condition for allowance. No new matter has been added to the application. Applicants express appreciation for thoughtful examination by the Examiner.

The present invention is a ball return device configured for use on a game table having a net such as table tennis. The device is a ramp placed parallel and adjacent to the entire length of a net on the game table as is shown in the figures and described in the accompanying text. End caps/brackets may be placed at the far edges of the net to further facilitate ball retrieval. Also, the ramp is configured not exceed the height of the net.

**Information Disclosure Statement**

The present action claims the foreign references filed with the Information Disclosure Statement were not considered because they do not contain a concise explanation of the relevance of those patents not in the English language. Applicants submit that the foreign patents, though related in technology, are not considered to adversely affect the patentability of the present invention. Further, although the foreign patents are not in English, the drawings of the 'simple' mechanical devices speak for

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themselves and that no translation is needed. Applicants therefore respectfully request consideration of the foreign patents.

**Claim Rejections Under 35 U.S.C. §112 are Overcome**

The Present Action rejects claims 3 and 19 as lacking antecedent basis for 'said top surface' and 'said extension portion' respectively. Applicants submit this rejection is moot by the foregoing amendments.

**Claim Rejections Under 35 U.S.C. §102(b) are Overcome**

The Office Action rejects claims 1-3, 6, 7, 9, 13, 16, 20 and 22 as being anticipated by Bodford, Jr. (U.S. 5,470,057), hereinafter "Bodford". Applicants respectfully traverse the rejection and request favorable reconsideration and withdrawal of this rejection. Further, Applicants submit this rejection is rendered moot by the foregoing amendments and the following comments.

The standard for a rejection under 35 U.S.C. §102(b) is established in MPEP §2131. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. If an independent claim is allowable under 35 U.S.C. §102, then any claim depending therefrom is also allowable.

A number of significant, material and functional differences exist between the present invention and the device shown by Bodford. Bodford describes a game having a pair of panels (ramps) forming an integral unit and partially extended the width of a table (col. 5, lines 1-10). The present invention of claim 1 uses only one ramp. To use

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Bodford, any net on the game table would have to be removed and fences are added to serve as a deflector (col. 2, lines 6-9). The present invention does not require fences as it extends the length of the net. Bodford is designed to receive a gameboard and is not designed for use as an aid for table tennis (col. 4, lines 47-50). The present invention is meant to act as an aid to the game of table tennis, and is not a game in itself. Also in Bodford, "the preferred embodiment of the deflector 12 has a height at its apex 26 substantially similar to that of a conventional table tennis net, namely seven inches" (col. 5, lines 43-46). The present invention requires it to be a height less than a standard table tennis net.

As to the specific rejections, the present action rejects claims 1, 2, 6, 7 and 16 under Bodford stating that Bodford's ramps 22a and 22b are inherently capable of being placed adjacent to a game table net. Bodford discloses these ramps as a pair of generally rectangular panels 22a and 22b. Claim 16 has been cancelled. Claims 2, 6 and 7 depend from claim 1 and if claim 1 is in condition for allowance, so to are the dependent claims. As stated in claim 1 of the present invention, the single ramp is used and is positioned at a point on the net to be substantially parallel to the net and sloped to facilitate movement of a ball away from the net. Applicants submit if ramps 22a and 22b were placed adjacent to a game table net a ball hitting the net would actually be trapped by the ramp adjacent to the net. As stated above, Bodford actually requires removal of the table's net.

Further, as stated above, there are several other significant differences between Bodford and the present invention. Nevertheless, to define the differences between Bodford and the present invention more clearly, claim 1 has been amended to include

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specific reference and limitation to the ramp as extending the length of the net and at a height lower than the top of the table tennis net. These references are clearly supported and illustrated in the figures of the present application.

The present action rejects claims 3, 13, 20 and 22, as Bodford claims the support elements 18a and 18b. Applicant submits that Claims 3 and 13 depend from amended claim 1, and believed to be in condition for allowance. As to the rejection of claims 3 and 13, the claims as presented do not purport to singularly support a ramp, but rather the use of a support in connection with the device as described in amended claim 1. The same argument applies to claims 20 and 22. Accordingly it is believed that these dependent claims are allowable over the prior art.

The present action rejects claim 9 stating tabs 20a and 20b are broadly considered to be hooks. The claim as presented does not purport to singularly support the use of hooks, but rather the use of a hook as the connection in connection with the device as described in claim 1. Accordingly it is believed this dependent claim is allowable over the prior art.

In light of the above, Applicants respectfully submit they have addressed the all aspects of the rejections under 102(b) and demonstrated that Applicants' invention, as claimed in amended claim 1, is not anticipated nor suggested by Bodford. Accordingly, Applicants request Examiner to withdraw the rejections under 35 U.S.C. §102(b). Claim 1 and those claims that depend from claims 1 and 17 are in condition for allowance over the art of record, and Applicants respectfully request such allowance.

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**Claim Rejections Under 35 U.S.C. §103(a) are Overcome**

The office action rejects original claims 10-12 under 35 U.S.C. §103(a) as being obvious in light of Bodford. The present action states it would have been obvious to one skilled in the art to make the ramps separable in claim 10 and held together frictionally (claim 11) or telescopingly (claim 12). Applicants respectfully traverse the rejection and request reconsideration and withdrawal thereof. Applicants submit claims 10-12 as presented do not purport to singularly support separation and means to hold them together, but rather the use these modifications in connection with the device as described in amended claim 1.

The standard to be applied in a 35 U.S.C. §103(a) rejection is established in MPEP §2143.03. To establish *prima facie* obviousness of a claimed invention, all the claimed limitations must be taught or suggested by the prior art. If an independent claim is non-obvious under 35 U.S.C. §103, then any claim depending therefrom is non-obvious.

In light of the above, Applicants respectfully submit they have addressed the all aspects of the rejections under 103(a) and demonstrated that Applicants' invention, as claimed in amended claim 1, is not anticipated nor suggested by Bodford nor obvious.

**Double Patenting**

The present action claims that should claim 6 be allowed, claim 16 would be objected to under 37 CFR 1.75 as being a substantial duplicate thereof (MPEP 706.03(k)). Applicants have addressed this potential objection by canceling claim 16 and, as such, believe this objection to now be moot.

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### **Allowable Subject Matter**

The present action states claims 4, 5, 8, 14, 15, 17, 18, 19 (if antecedent basis rejection is overcome) and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants have rewritten claim 4 as an independent claim to include the limitations as requested including all intervening claims and claim 5 depends from amended claim 4. Similarly, claims 8 and 14 have been rewritten into independent form and claim 15 depends from amended claim 14. Similarly, claim 17 has been rewritten into independent form and claims 18 and 19 depend from amended claim 17. Similarly, claim 21 has been rewritten in independent form. Further, claim 19 has also been amended to address the antecedent basis rejection. Applicants therefore believe claims 4, 5, 8, 14, 15, 17, 18, 19 and 21 are in condition of allowance, and respectfully request such allowance.

### **CONCLUSION**

Examiner noted that the prior art of record was considered pertinent to Applicants' disclosure. Applicants have reviewed the prior art of record and submit it does not adversely bear on the patentability of the pending claims.

In light of the foregoing, Applicants respectfully submit that they have addressed each and every item presented by the Examiner in this Office Action. Favorable reconsideration of all of the claims as amended is earnestly solicited. Applicants submit

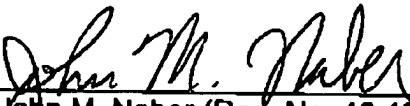
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that the present application, with the foregoing claim amendments and accompanying remarks, is in a condition for allowance and respectfully request such allowance.

In the event any further matters requiring attention are noted by Examiner or in the event that prosecution of this application can otherwise be advanced thereby, a telephone call to Applicants' undersigned representative at the number shown below is invited.

Respectfully submitted,

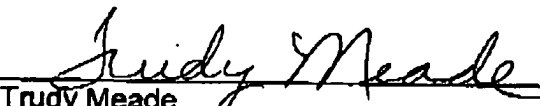
Date: October 28, 2004

  
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